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EXAMINER

NGUYEN, DAVID Q

ART UNIT	PAPER NUMBER
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2681

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4

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/695,213

Applicant(s)

CIOTTA, BRUCE

Examiner

David Q Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 October 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 21 and 22 is/are rejected.
- 7) ☒ Claim(s) 14-20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-13 and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Obhan (US Patent Number 6366780) in view of the "Short Messaging", Telecommunication Systems, Inc., June 21, 2000.

Regarding claim 1, Obhan discloses in a wireless communication system, a method comprising the step of: transmitting a power-on signal from a mobile station to a mobile switching center (MSC) in response to each power activation of the mobile station (see col. 12, lines 25-36; col. 14, lines 46-54); transmitting a power-off signal from a mobile station to a mobile switching center (MSC) in response to each power deactivation of the mobile station (see col. 12, lines 25-36; col. 14, lines 46-54); updating power status of the mobile station in a home location register (HLR) linked to the MSC in response to receipt to each of said power-on signal and power-off signal (see col. 12, lines 25-36; col. 14, lines 46-54). Obhan is silent to disclose in response to each said step of updating, sending a message indicating a change of mobile station power status to an Internet Service Provider (ISP). However, the "Short Messaging", Telecommunication Systems, Inc., June 21, 2000 discloses in response to each said step of updating, sending a message indicating a change of mobile station power status to an Internet Service Provider (ISP) (see pages 66-86). Therefore, it would have been obvious to one of

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ordinary skill in the art at the time the invention was made to provide the above teaching of the “Short Messaging”, Telecommunication Systems, Inc., June 21, 2000 to Obhan so that system can notify buddies on power-up and users can automatically join favorite chat groups.

Regarding claim 2, Obhan discloses a method modified by the “Short Messaging”, Telecommunication Systems, Inc., June 21, 2000 comprising all of the limitations as claimed in claim 1. The “Short Messaging”, Telecommunication Systems, Inc., June 21, 2000 also discloses wherein the signal comprising information identifying the mobile station and its power status; in response to receipt of the signal by the ISP, correlating the mobile station identified in the signal with a subscriber of the ISP; determining whether the correlated ISP subscriber is on-line; and notifying the correlated on0line ISP subscriber of the power status of the mobile station (see pages 66-86). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the above teaching of the “Short Messaging”, Telecommunication Systems, Inc., June 21, 2000 to Obhan so that system can notify buddies on power-up and users can automatically join favorite chat groups.

Regarding claims 3-6, Obhan discloses a method modified by the “Short Messaging”, Telecommunication Systems, Inc., June 21, 2000 comprising all of the limitations as claimed. The “Short Messaging”, Telecommunication Systems, Inc., June 21, 2000 also discloses said step of notifying comprises transmitting data to the on-line ISP subscriber for display when the mobile station has been received; the data comprises an icon that indicates the mobile station has a power-on status; transmitting a message from the on-line ISP subscriber to the mobile station; said transmitting step comprises sending the message via the ISP to a short message server in the wireless communication system; and forwarding the message to the mobile station via the MSC

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(see pages 66-86). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the above teaching of the "Short Messaging", Telecommunication Systems, Inc., June 21, 2000 to Obhan so that system can notify buddies on power-up and users can automatically join favorite chat groups.

Regarding claim 7, Obhan discloses a method modified by the "Short Messaging", Telecommunication Systems, Inc., June 21, 2000 comprising all of the limitations as claimed. The "Short Messaging", Telecommunication Systems, Inc., June 21, 2000 also discloses wherein said step of notifying comprises transmitting data to the on-line ISP subscriber for deletion of an icon display when the mobile station has been de-activated (see pages 66-86). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the above teaching of the "Short Messaging", Telecommunication Systems, Inc., June 21, 2000 to Obhan so that system can notify buddies on power-up and users can automatically join favorite chat groups.

Regarding claim 8, Obhan discloses a method modified by the "Short Messaging", Telecommunication Systems, Inc., June 21, 2000 comprising all of the limitations as claimed. The "Short Messaging", Telecommunication Systems, Inc., June 21, 2000 also discloses the signal comprises information identifying the mobile station and its power status, and the step of transmitting comprises forwarding the signal to a plurality of ISPs (see pages 66-86). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the above teaching of the "Short Messaging", Telecommunication Systems, Inc., June 21, 2000 to Obhan so that system can notify buddies on power-up and users can automatically join favorite chat groups.

Regarding claim 9, Obhan discloses in a wireless communication system, a method comprising the step of: transmitting a power-on signal from a mobile station to a mobile switching center (MSC) in response to each power activation of the mobile station (see col. 14, lines 46-54; col. 12, lines 25-36); transmitting a power-off signal from a mobile station to a mobile switching center (MSC) in response to each power deactivation of the mobile station (see col. 14, lines 46-54; col. 12, lines 25-36); updating power status of the mobile station in a home location register (HLR) linked to the MSC in response to receipt to each of said power-on signal and power-off signal (see col. 14, lines 46-54; col. 12, lines 25-36). Obhan is silent to disclose in response to each said step of updating, determining whether the mobile station is associated with a subscriber of an Internet Service Provider (ISP); and transmitting a change of mobile station power status signal to a remote database associated with the ISP if an association has occurred in the determining step. However, the “Short Messaging”, Telecommunication Systems, Inc., June 21, 2000 discloses disclose in response to each said step of updating, determining whether the mobile station is associated with a subscriber of an Internet Service Provider (ISP); and transmitting a change of mobile station power status signal to a remote database associated with the ISP if an association has occurred in the determining step (see pages 66-86). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the above teaching of the “Short Messaging”, Telecommunication Systems, Inc., June 21, 2000 to Obhan so that system can notify buddies on power-up and users can automatically join favorite chat groups.

Regarding claim 10, Obhan discloses a method modified by the “Short Messaging”, Telecommunication Systems, Inc., June 21, 2000 comprising all of the limitations as claimed.

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The “Short Messaging”, Telecommunication Systems, Inc., June 21, 2000 also discloses checking a flag in the HLR indicating that the mobile station is linked to the Internet Service Provider (see pages 66-86). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the above teaching of the “Short Messaging”, Telecommunication Systems, Inc., June 21, 2000 to Obhan so that system can notify buddies on power-up and users can automatically join favorite chat groups.

Regarding claim 11, Obhan discloses a method comprising the steps of: maintaining power-on and power-off status for each of a plurality of mobile telephone stations in a first database (see col. 14, lines 46-54; col. 12, lines 25-36). Obhan is silent to disclose formulating a change of status message for transmission to a second database related to at least one Internet Service Provider (ISP) in response to a change in the status for at least one of the plurality of mobile stations. However, the “Short Messaging”, Telecommunication Systems, Inc., June 21, 2000 discloses formulating a change of status message for transmission to a second database related to at least one Internet Service Provider (ISP) in response to a change in the status for at least one of the plurality of mobile stations (see pages 66-86). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the above teaching of the “Short Messaging”, Telecommunication Systems, Inc., June 21, 2000 to Obhan so that system can notify buddies on power-up and users can automatically join favorite chat groups.

Regarding claim 12, Obhan discloses a method modified by the “Short Messaging”, Telecommunication Systems, Inc., June 21, 2000 comprising all of the limitations as claimed in claim 11. The “Short Messaging”, Telecommunication Systems, Inc., June 21, 2000 also

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discloses the first database comprises a mobile switching system home location register (HLR) that contains subscriber listing for the plurality of mobile stations and the step of maintaining comprises: receiving at a mobile switching center (MSC) power-on and power-off signals that are indicative of changes in a power status for each of the plurality of mobile stations; and updating the HLR in response to the received power-on and power-off signals (see pages 66-86). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the above teaching of the "Short Messaging", Telecommunication Systems, Inc., June 21, 2000 to Obhan so that system can notify buddies on power-up and users can automatically join favorite chat groups.

Regarding claim 13, Obhan discloses a method modified by the "Short Messaging", Telecommunication Systems, Inc., June 21, 2000 comprising all of the limitations as claimed in claim 12. Obhan also discloses receiving at the MSC registration and de-registration signals, indicative of establishing communication and loss of communication, respectively, with mobile communications network base stations for each of the plurality of mobile stations (see col. 14, lines 46-54; col. 12, lines 25-36); wherein the HLR is updated further in response to receipt of the registration and deregistration signals (see col. 14, lines 46-54; col. 12, lines 25-36). And the "Short Messaging", Telecommunication Systems, Inc., June 21, 2000 discloses formulating a change of registration message for transmission to a second database related to at least one Internet Service Provider (ISP) in response to a change in the registration for at least one of the plurality of mobile stations (see pages 66-86). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the above teaching of the

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“Short Messaging”, Telecommunication Systems, Inc., June 21, 2000 to Obhan so that system can notify buddies on power-up and users can automatically join favorite chat groups.

Regarding claim 21, Obhan discloses a wireless communications system comprising: a plurality of mobile stations (see fig. 3); a plurality of base stations interfaced for wireless communications with the plurality of mobile stations and for receiving power status transmissions from the mobile stations (see fig. 3 and explanation in claim 1); a mobile switching center connected in a wireless communication network to the base stations, the mobile switching center linked to a home location register for transmission thereto of changes of power status of the mobile stations, the home location comprising service profiles for each mobile station, including power status (see fig. 3 and explanation in claim 1). Obhan is silent to disclose a database remote from the home location register, the remote database associated with an Internet Service Provider and containing records relating subscribers of the Internet Service Provider with respective mobile stations, the remote database connected through a data network with the home location register for receiving therefrom change of power status messages for the respective mobile stations. However, the “Short Messaging”, Telecommunication Systems, Inc., June 21, 2000 discloses a database remote from the home location register, the remote database associated with an Internet Service Provider and containing records relating subscribers of the Internet Service Provider with respective mobile stations, the remote database connected through a data network with the home location register for receiving therefrom change of power status messages for the respective mobile stations (see pages 66-86). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the above teaching of the “Short Messaging”,

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Telecommunication Systems, Inc., June 21, 2000 to Obhan so that system can notify buddies on power-up and users can automatically join favorite chat groups.

Regarding claim 22, Obhan discloses a system modified by the "Short Messaging", Telecommunication Systems, Inc., June 21, 2000 comprising all of the limitations as claimed. The "Short Messaging", Telecommunication Systems, Inc., June 21, 2000 also discloses the storage device comprises a computer and a database communicating with the computer (see pages 66-86). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the above teaching of the "Short Messaging", Telecommunication Systems, Inc., June 21, 2000 to Obhan so that system can notify buddies on power-up and users can automatically join favorite chat groups.

Allowable Subject Matter

2. Claims 14-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent from including all of the limitations of the base claim and any intervening claims.

Regarding claim 14, Obhan discloses a method modified by the "Short Messaging", Telecommunication Systems, Inc., June 21, 2000 comprising all of the limitations as claimed. They are silent to disclose wherein the second database contains a table associated with the ISP, the table contains records of respective mobile identification numbers (MIN's) of mobile stations that are provisioned for power-on and power-off status transmissions to the ISP, and further comprising the steps of transmitting a change of status message to the second database; comparing the MIN contained in the change of status message with the table associated with the

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ISP; in response to a match of the MIN in the comparing step, updating the record containing the MIN to reflect the status contained in the change of status message; and providing to the ISP subscriber data indicating the status of the mobile station if the ISP subscriber is on line, as specified in claim 14.

Claims 15-16 depend on claim 14. Therefore, They are objected.

Regarding claim 17, Obhan discloses a method modified by the "Short Messaging", Telecommunication Systems, Inc., June 21, 2000 comprising all of the limitations as claimed. They are silent to disclose the second database is stored in a processor remote from the location of the HLR and contains a plurality of tables associated with respective ISP's, each of the tables relating subscribers of its respective ISP with mobile identification numbers (MIN'S) of mobile stations; the step of maintaining further comprises setting a flag in the HLR database for each MIN that is listed in the second database; and the step of formulating comprises identifying a flag in the HLR for the mobile station that has changed status; the method further comprising the step of transmitting the change of status message to the second database, as specified in claim 17.

Claim 18 depends on claim 17. Therefore, claim 18 is objected.

Regarding claim 19, Obhan discloses a method modified by the "Short Messaging", Telecommunication Systems, Inc., June 21, 2000 comprising all of the limitations as claimed. They are silent to disclose the second database is stored in a processor remote from the location of the HLR and contains a plurality of tables associated with respective ISP's, each of the tables relating subscribers of its respective ISP with mobile identification numbers (MIN'S) of mobile stations; the step of maintaining further comprises setting a flag in the HLR database for each

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MIN that is listed in the second database; and the step of formulating comprises identifying a flag in the HLR for the mobile station that has changed registration; the method further comprising the step of transmitting the change of registration message to the second database, as specified in claim 19.

Claim 20 depends on claim 19. Therefore, claim 20 is objected.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Q Nguyen whose telephone number is 7036054254. The examiner can normally be reached on 8:30AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh Tran can be reached on 703-605-4040. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

DN

David Nguyen

Sinh Tran

**SINH TRAN
PRIMARY EXAMINER**